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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/580,226

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EXAMINER

WELTER, RACHAEL E

ART UNIT

PAPER NUMBER

1611

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DELIVERY MODE

05/11/2010

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/580,226	Applicant(s) KAWAHARA, TAKEMASA	
	Examiner RACHAEL E. WELTER	Art Unit 1611	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 5/22/06.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>8/18/06</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Status

Claim 1 is pending.

Information Disclosure Statements

The information disclosure statement (IDS) submitted on August 18, 2006 was in compliance with the provisions of 37 CFR 1.97 and 37 CFR 1.98. A signed copy of form 1449 is enclosed herewith.

Specification

The specification contains many translational and grammatical errors. As such, a substitute specification in proper idiomatic English and in compliance with 37 CFR 1.52(a) and (b) is required. The substitute specification filed must be accompanied by a statement that it contains no new matter.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claim 1 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in

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the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Claim 1 recites a body sticking sheet, with a small degree of shrinkage applied to an affected area, and a portion with a large degree of shrinkage around the former portion.

Although applicant describes the design of the body sticking sheet and discloses drawings of the body sheets in the instant specification, applicant does not describe what material the body sheet is made of. More specifically, applicant does not describe what the portion with a small degree of shrinkage is made of and how it differs from the portion with a large degree of shrinkage. Instead, applicant is merely describing the instant product in functional terms. As such, applicant has not shown to be in possession of the full scope of the claimed invention.

To satisfy the written description requirement, a patent specification must describe the claimed invention in sufficient detail that one skilled in the art can reasonably conclude that the inventor had possession of the claimed invention. See, e.g., *Moba, B.V. v. Diamond Automation, Inc.*, 325 F.3d 1306, 1319, 66 USPQ2d 1429, 1438 (Fed.Cir. 2003); *Vas-Cath, Inc. v. Mahurkar*, 935 F.2d at 1563, 19 USPQ2d at 1116. Applicant shows possession of the claimed invention by describing the claimed invention with all of its limitations using such descriptive means as words, structures, figures, diagrams, and formulas that fully set forth the claimed invention. *Lockwood v. American Airlines, Inc.*, 107 F.3d 1565, 1572, 41 USPQ2d 1961, 1966 (Fed. Cir. 1997). Possession may be shown in a variety of ways including description of an actual

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reduction to practice, or by showing that the invention was “ready for patenting” such as by the disclosure of drawings or structural chemical formulas that show that the invention was complete, or by describing distinguishing identifying characteristics sufficient to show that the applicant was in possession of the claimed invention. See, e.g., *Pfaff v. Wells Elecs., Inc.*, 525 U.S. 55, 68, 119 S.Ct. 304, 312, 48 USPQ2d 1641, 1647 (1998). Applicant may also show that an invention is complete by disclosure of sufficiently detailed, relevant identifying characteristics which provide evidence that applicant was in possession of the claimed invention, i.e., complete or partial structure, other physical and/or chemical properties, functional characteristics when coupled with a known or disclosed correlation between function and structure, or some combination of such characteristics.

Applicant describes that two types of raw materials having different degrees of shrinkage are combined to form a portion with a small degree of shrinkage and a portion with a large degree of shrinkage on pg. 6 of the specification. However, applicant does not explicitly describe these raw materials and what they are comprised of. Applicant also does not describe how different the degrees of shrinkage in each portion are from each other. Terms such as, “small degree” and “large degree” are relative terms that convey little meaning to the ordinary skilled artisan in assessing the scope of the invention.

As such, the claims lack adequate written description and do not reasonably convey to one skilled in the art that applicant had possession of the claimed invention.

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The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 1 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

As described above, claim 1 recites a body sticking sheet, with a small degree of shrinkage applied to an affected area, and a portion with a large degree of shrinkage around the former portion. The term "small degree" and "large degree" in claim 1 are relative terms which render the claim indefinite. The terms are not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention. Since applicant does not provide any standard for these terms, it is difficult to compare the two different portions on the body sheet.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claim 1 is rejected under 35 U.S.C. 102(b) as being anticipated by Gordon (US Patent 3,329,143).

Gordon teaches a shrinkable plastic bandage cover that is placed over a bandage or cast to protect the bandage from being contaminated by dirt, grease, liquids, etc. without undesirably constricting the bandage itself about the injured part which the bandage covers (column 1, lines 8-15; Figures 1-5). The bandage cover shrinks only when in a heated state.

The examiner is interpreting the bandage and bandage cover in Gordon to be the former portion applied to an affected area and the portion with a large degree of shrinkage in claim 1 respectively. Since the bandage cover is highly shrinkable, it is expected that it would have a large degree of shrinkage relative to the bandage.

Claim 1 is rejected under 35 U.S.C. 102(b) as being anticipated by JP 6339495 (See machine translation; attached herein).

JP' 495 teaches a gauze containing a sterilant or an antiseptic solution surrounded by a support member that may contract and extend in the direction of arrow (A') (see Figures 1-11 in non-translated patent; paragraphs 0006, 0009).

The examiner is interpreting the support member's expandable/contractible properties to indicate that it is shrinkable. Thus, it is expected that the support member would have a large degree of shrinkage relative to the gauze or padding.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

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(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claim 1 is rejected under 35 U.S.C. 102(e) as being anticipated by Liguori (US Publication No. 2003/0023197).

Liguori teaches a shrink-wrap bandage adapted to accommodate characteristics of the target application or wound site, including the size, shape, and mobility thereof (abstract; paragraph 0002). In Figure 2, a bandage is taught which comprises a padding or gauze surrounded by a shrinkable film and adhesives (paragraph 0041).

Since the bandage film is highly shrinkable, it is expected that it would have a large degree of shrinkage relative to the gauze or padding.

Conclusion

Claim 1 is rejected. No claim is allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to RACHAEL E. WELTER whose telephone number is (571) 270-5237. The examiner can normally be reached on 7:30-5:00 Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sharmila Landau can be reached on 571-272-0614. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

REW

/Lakshmi S Channavajjala/
Primary Examiner, Art Unit 1611
May 9, 2010